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10/076,978	02/15/2002	Edward Sax	F-8040	1405

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LERNER AND GREENBERG, P.A.  
PATENT ATTORNEYS AND ATTORNEYS AT LAW  
Post Office Box 2480  
Hollywood, FL 33022-2480

[REDACTED] EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
3679	[REDACTED]

DATE MAILED: 05/09/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/076,978	SAX ET AL.
	Examiner Ryan M Flandro	Art Unit 3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 February 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 16 and 19-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16 and 19-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 07 February 2003 is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Claims 16-29 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Specifically, in relation to added claims 36-39, the specification fails to provide support for the recited "tensioning system," "tensioning posts," and "plurality of tensioners." Additionally, recitation of "fastening locations" in claims 16, 35, 38, and 39 is unsupported by the language of the specification. And further, recitation of the wire lath defining an "unsupported fence bottom" is not supported by the original disclosure.

3. The use of the trademark MAX-FLEX has been noted in this application (page 14, line 12). It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

*Drawings*

4. The corrected or substitute drawings were received on 07 February 2003. These drawings are acceptable.

5. The drawings are, however, further objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wires being cut (or having free ends) between said end fence posts and said ratcheting posts compressing said wire lathe (claims 16, 28, 35, 36, 38, and 39) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Claim Objections*

6. Applicant is advised that should claim 16 be found allowable, claim 35 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Likewise, Applicant is advised that should claim 38 be found allowable, claim 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant should note that the recitation "an intermediate fence system" (claims 16 and 38) and "a fence system" (claims 35 and 39) have not been given patentable weight because the

recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 31 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, recitation of the wire lath defining an “unsupported fence bottom” constitutes new matter.

9. Claims 36-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, recitation of “two **tensioning posts**” (claim 36, lines 5, 7, 9; claim 37, line 2; claim 38, lines 4, 5, 10, 18; claim 39, lines 3, 4, 9, 17), “a plurality of

**tensioners**" (claim 36, lines 6, 10; claim 38, lines 7, 12, 14; claim 39, lines 6, 11, 13), and "a **tensioning system**" (claim 38, line 4; claim 39, line 3) is not supported by the original disclosure and thus constitutes new matter.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 recites the limitation "said fence coating". There is insufficient antecedent basis for this limitation in the claim because such limitation was removed from claim 28 in the Amendment.

12. The previous rejection of claim 27 under 35 U.S.C. §112, 2<sup>nd</sup> Paragraph, is hereby withdrawn in light of applicant's argument on this issue (paper no. 9, page 8).

*Claim Rejections - 35 USC § 103*

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 16 and 19-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunch (US 355,135) in view of Miller et al (US 4,031,285) (Miller) and further in view of Waggoner et al (US 6,355,333) (Waggoner), as applied in the previous Office action (paper no. 8).

a. Claims 16, 35, 38, and 39. Bunch shows and discloses an (intermediate) fence construction system, comprising a plurality of fence posts including end fence posts; a ratcheting system (or tensioning system) including at least two temporary ratcheting posts (or tensioning posts), at least one of the ratcheting posts (or tensioning posts) having a plurality of fastening locations; a plurality of ratchets (or tensioners) secured at least at some of said fastening locations; a plurality of high-tension tensile wires running between said temporary ratcheting posts (or tensioning posts) and secured to the plurality of fence posts, at least one end of each of said high-tension tensile wires being connected to a respective one of said ratchets (or tensioners), said high-tension tensile wires being tensioned to a pre-determined tension by actuating said ratchets (or tensioners); said high-tension tensile wires being cut between said end fence posts and said ratcheting posts (or tensioning posts) (see figures 1-3; column 1 line 44 – column 2 line 64).

i. Bunch fails to disclose a wire lath secured to said plurality of high-tension tensile wires and said fence posts as well as the cut high-tension tensile wires compressing said wire lath.

ii. Waggoner teaches that a wire lath secured to a plurality of high-tension tensile wires and fence posts is old in the art for creating a fence with a wall appearance (figure 1; column 2 line 46 – column 3 line 5).

iii. Further, Miller teaches cut high-tension tensile wires compressing a wall structure in order to improve the strength of the wall (figure 3; column 2 lines 9-26; column 3 lines 46-48, 56-58, 63-66; column 4 lines 20-31).

Art Unit: 3679

- iv. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the tensioned fence of Bunch by providing a wire lath secured to the wires and fence posts as well as cutting the ends of the wires in order to provide strength to the wall through compression as taught by Waggoner and Miller.
- b. Claim 19. The combination of Bunch, Miller, and Waggoner, as set forth above, includes said wire lath being metal (Waggoner column 2 line 61), but lacks explicit disclosure that said high-tension tensile wires and the wire lath are galvanized. It has generally been recognized, however, that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The use of galvanized metal for tensioned wires and wire laths is well known. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a galvanized metal material to construct the tensioned wires and wire lath of the combination of Bunch, Miller, and Waggoner as such practice is a design consideration within the skill of the art.
- c. Claim 20. The combination of Bunch, Miller, and Waggoner, as applied above, includes a fence coating (22, 24, 26) applied to the wire lath (see Waggoner column 2, line 46 – column 3, line 5), and said high-tension tensile wires compressing said fence coating together with said wire lath.
- d. Claim 21. The combination of Bunch, Miller, and Waggoner teaches the fence coating including a scratch coat (22) applied to the wire lath, a brown coat (24) applied to

the scratch coat and a finish coat (26) applied to the brown coat (Waggoner column 2, line 46 – column 3, line 5).

e. Claim 22. The combination of Bunch, Miller, and Waggoner further includes the scratch coat being a Portland cement mixture (Waggoner column 2, line 46 – column 3, line 5). Waggoner does not explicitly teach that the Portland cement mixture is the type containing polymers, various fiber particles and selected sizes of aggregate. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The use of a Portland cement of the type containing polymers, fiber particles and selected sizes of aggregate for scratch coats is well known. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a Portland cement of the type containing polymers, fiber particles for the scratch coat as such practice is a design consideration within the skill of the art.

f. Claim 23. The combination of Bunch, Miller, and Waggoner includes the brown coat being of the same mixture as the scratch coat (Waggoner column 2, line 46 – column 3, line 5).

g. Claim 24. The combination of Bunch, Miller, and Waggoner does not expressly include the scratch coat and the brown coat being of about 3/8". It has generally been recognized, however, that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

- h. Claim 25. The combination of Bunch, Miller, and Waggoner further includes a paint applied on the fence coating (Waggoner column 2, line 46 – column 3, line 5).
- i. Claim 26. The combination of Bunch, Miller, and Waggoner includes the paint being a color coat (Waggoner column 3 lines 4-5). Note that the claim language does not require both a prime coat and color coat but rather “one of a prime coat and a color coat”.
- j. Claim 27. The combination of Bunch, Miller, and Waggoner does not expressly include a pre-constructed non-structural decoration column. Applicant’s admission in the Amendment filed 07 February 2003 (paper no. 9, page 8, second full paragraph) that the decoration column has “no structural function for the fence” is noted and the Examiner has, therefore, not given this recitation any patentable weight. Ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).
- k. Claim 28. The combination of Bunch, Miller, and Waggoner, as applied above, includes a fence comprising a plurality of fence posts; a plurality of high-tension tensile wires secured to the plurality of fence posts, said high-tension tensile wires being tensioned to a predetermined tension and having free ends; a wire lath secured to the plurality of high-tension tensile wires; and said fence posts and being compressed by said high-tension tensile wires (see specifically subparagraph 14(a) above).
- l. Claim 29. The combination of Bunch, Miller, and Waggoner includes a paint applied to a surface of the fence coating (Waggoner column 2, line 46 – column 3, line 5).
- m. Claims 31 and 33. The combination of Bunch, Miller, and Waggoner includes the wire lath defining an unsupported bottom (see especially Bunch figure 1).

- n. Claim 32. The combination of Bunch, Miller, and Waggoner, as applied to claim 28 above, includes a fence coating applied to said wire lath, said high-tension tensile wires compressing said fence coating together with said wire lath (see subparagraph 14(k) above).
- o. Claim 34. The combination of Bunch, Miller, and Waggoner, as applied above, includes said fence posts including end fence posts and said high-tension tensile wires being unattached beyond said end fence posts.
- p. Claims 36 and 37. Construction of the fence system of the combination of Bunch, Miller, and Waggoner, as applied above, would include the steps enumerated in claims 36 and 37. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification, it can be assumed the device will inherently perform the same process. *In re King*, 802 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

15. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bunch, Miller, and Waggoner, as applied above, further in view of Larsen (US 1,030,411). The combination of Bunch, Miller, and Waggoner, as applied to claim 16 above, lacks disclosure of at least one supporting post for supporting at least one of said ratcheting posts. Larsen, however, teaches that it is very common in the art to include at least one supporting post **8** for supporting at least one ratcheting post **1** in a wire stretching system. Therefore, it would have been obvious

to one having ordinary skill in the art at the time the invention was made modify the fence system of the combination of Bunch, Miller, and Waggoner by providing at least one supporting post in order to provide a brace to a ratcheting post as taught by Larsen.

***Response to Arguments***

16. Applicant's arguments with respect to claims 16, 28, and newly added claims 30-39 have been considered but are moot in view of the new ground(s) of rejection.

17. In response to Applicant's argument that there is "not any tension in the wires 14" of Waggoner (paper no. 9, page 10), the Examiner notes that the wires 14 are shown to be taut in figure 1 and will therefore have some amount of tension therein.

18. In response to Applicant's argument that "in Waggoner et al., the lath 18 is not secured to the wires 14, but rather to a barrier sheet 16" (paper no. 9, page 11) the Examiner points out that "the wires 14 are...covered with a barrier sheet" (column 2 lines 53-54), the lath 18 then being applied over the barrier sheet 16" (column 2 lines 61-63). According to this construction then, the lath is in fact secured to the wires. The fact that Waggoner discloses additional structure (i.e., the barrier sheet 16) not claimed is irrelevant.

19. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the bottom of the wall structure not being secured to the ground – paper no. 9, page 11) was not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, addition of such recitation in newly added claims 31 and 33 is not supported by the original disclosure as pointed out above in paragraph 8.

***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to fence construction systems:

U.S. Patent 4,903,446 to Richards et al.

U.S. Patent 4,029,037 to Hogan

U.S. Patent 3,086,273 to Welborn

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RMF  
May 1, 2003



Lynne H. Browne  
*Supervisory Patent Examiner*  
Technology Center 3670